

Appl. No. 10/791,074, Filed March 2, 2004
Response Dated September 28, 2006
Reply to Restriction Requirement dated August 31, 2006

IFW



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: **John J. Dunn, et al.** Confirmation No.: **7913**
Application No.: **10/791,074** Examiner: **M. L. Shibuya**
Filing Date: **March 2, 2004** Art Unit: **1639**
Title: **GENOME SIGNATURE TAGS**

RESPONSE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

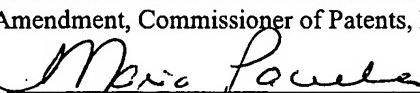
In response to the Restriction Requirement set forth in the Office Communication dated August 31, 2006, Applicants elect the claims of Group I, claims 1-22, 50-55 and 58-63 with traverse.

The Agent for the Applicants concurs with the Examiner that Claims 1 – 22 and 58 – 63 are drawn to methods for analyzing organismic complexity of a sample, but requests the Examiner's reconsideration of the inclusion of Claims 50-55 in Group I. This request is based upon the Examiner's additional identification of Claims 50 – 55 as comprising a separate invention, i.e., Group III, drawn to a method for analyzing the variety of members of specific phyla or families of organisms contained in a sample. The Group I and Group III inventions as claimed are related but are distinct. They have a materially different design, mode of operation

CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any papers referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

9/28/06
Date



Maria Pacella, Office of Intellectual Property and Sponsored Research

and function. Thus the Agent requests the Examiner's reconsideration of the composition of Group I and requests that it be changed to include only Claims 1-22 and 58-63.

In paragraphs 5 through 20, the Examiner states that the elected Claims 1, 3, 4, 7, 8, 9, 11, 12, 16, 17, 18-22, 50-55, 58-61, and 63 (and others that are not members of Group I) are generic and variously contain claims directed to patentably distinct species. Therefore, the Examiner has requested election of species for each. The Agent for the Applicants respectfully traverses this request for election of species and requests reconsideration and withdrawal, in whole or in part, of this requirement. Prior to presenting the individual reasoning for requesting reconsideration for each of the specific elements identified by the Examiner, the Agent for the Applicants respectfully requests the Examiner's consideration of the general theme on which this traversal is based:

MPEP 806.04(d) states:

“... for example, ... a generic claim should read on each of these views; but the fact that a claim does so read is not conclusive that it is generic. It may define only an element or subcombination common to several species.

In general, a generic claim should require no material element additional to those required by the species claim, and each of the species claims must require all the limitations of the generic claim.”

MPEP 808.01(a) states:

Election of species should not be required between claimed species that are considered clearly unpatentable over each other.” (emphasis added)

The Agent for the Applicants requests the Examiner reconsider the designation of the claims as generic and further reconsider whether a requirement of election of species is proper. It is the Applicants' position that the claimed invention can be practiced with a variety of interchangeable elements. Further, if a single species for each of the elements identified in paragraphs 5 through 20 were to be elected and used to carry out the method of the elected invention (i.e., used to analyze the organismic complexity of a sample) the practiced method would not be patentably distinct from the method if it was to be practiced with an entirely different set of individual elements. Furthermore, the elected invention as claimed does not claim the elements and thus cannot be a generic claim. The invention can be practiced with a variety of combinations of the elements and the practitioner can then achieve the outcome of the claim, i.e., the practitioner will have analyzed the organismic complexity of a sample regardless of which specific elements were utilized, particularly since each of the elements is under the limitations provided in the base claims.

In addition, the Examiner has not put forth a clear indication that there are such a large number of claimed species that a serious burden on the examiner is created. In fact, for example, Claim 1 is a claim to a single method for analyzing the organismic complexity of a sample. The claim is broad and the method of the invention makes use of many elements which can be selected based on the particular needs of the practitioner of the invention. However, it is a claim to only one method and therefore does not include species.

Should the above not persuade the Examiner to reconsider requiring election of species, the following item by item responses to paragraphs 5 through 20 is presented in furtherance of